

REMARKS

Claims 1-16 and 18-61 are pending. By this amendment, claim 20 is amended. No new matter is introduced. Reconsideration and issuance of a Notice of Allowance are respectfully requested.

I. REJECTIONS UNDER 35 U.S.C. § 102(b) OVER THE PLAIN OLD TELEPHONE SYSTEM (POTS)

On page 2 the Office Action rejects claims 1, 2, 9, 13, 18 - 25, 27, 29 - 31, 35, 37, 39, 40, 45, 46, and 50 under 35 U.S.C. § 102 (b) "as being anticipated by telephone companies, including Bell telephones (so-called, Ma Bell). This rejection is respectfully traversed.

In particular, and considering independent claims 1, 18 - 20, 27, 37, and 45, the Office Action states that "it is old and well known for telephone companies to provide one or more hardware products (telephones), a metering mechanism coupled to the hardware products that acquires metrics data from the hardware product [sic], the metering data determines data to report on the operation of the products and generates reports, the metering mechanism is inherent in that bills are generated based on telephone usage and these inherently come from metering."

In essence, the Examiner is "taking official notice" of supposed facts in order to support the rejection of these claims. Nowhere does the Examiner provide any documentation to support this rejection. In section 2144.03, the MPEP states "It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." Furthermore, "It is never appropriate to rely solely on 'common knowledge' [as the Office Action does in rejecting the independent claims] in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based."

Applicants respectfully disagree that all the elements of the independent claims are disclosed by any plain old telephone system (POTS). Applicants cannot respond completely to this undocumented rejection. In accordance with MPEP 2144.03, Applicants traverse the Office Action's reliance on "common knowledge" and ask the Examiner to provide specific documentary evidence to support the rejection of claims 1, 18 - 20 27, 37, and 45, and their respective dependent claims 2, 9, 13, 21 - 25, 29 - 31, 35, 39, 40, 46, and 50. Applicants

assert that a careful review of the POTS reveals that, in fact, this system does not anticipate the claimed subject matter.

A. The POTS

The POTS allows voice communication between two devices, or among three or more devices. Users of the POTS are charged a fee for such voice communications. The fee is calculated based on established rates for local and long-distance calls, for example, and further based on recorded usage in units of time (e.g., minutes) over which the voice communication occurs. Thus, when a call “matures,” the call start time is recorded, and when the receiver goes “on-hook” the call stop time is recorded. The recorded start and stop times are provided to a billing system. Note that in the POTS, phone usage is not calculated; instead, phone usage is recorded. In the POTS, the fees charged for phone usage are calculated based on the recorded usage. Thus, in the POTS, there is no determination, by a metering mechanism, of data to report; the data (start/stop times) reported are instead simply recorded (acquired) and then reported at some time subsequent to the conclusion of the voice communication.

Another data element recoded in the POTS is the Automatic Number Identifications (ANIs) of the dialing and dialed telephone. For rotary phone, the number dialed is determined by counting pulses as the dial returns to its original position. For digital phone, one standard method is use of different frequency signals for each number dialed. In any event, the pulses and frequencies simply are recorded (at a central office or remote switch), and are used to enable call connection. There is no function of “determining data to report” on the operation of the telephone.

B. The Claims

1. Claim 1

Considering claim 1, as noted above, Applicant contends that no POTS ever included a “metering mechanism [that] determines data to report on the operation of the one or more hardware products” (emphasis added), as recited in claim 1. Referring to the specification, metering mechanism 113 determines what data to report. The metering mechanism 113 is shown in Figure 3, and is described in detail at least at page 6, line 4 to page 12, line 21. The metering mechanism 113 includes a rules engine 151, a processor 153, and a data acquisition engine 159 that work together to acquire, process, and report specific data related to the usage of the hardware device. When determining what data to report, the processor 153 and the

rules engine 151 may, for example, determine an average CPU utilization for each five minute interval in a day. See page 11, lines 5 - 9.

Furthermore, claim 1 also recites "a usage repository" Nowhere does the Office Action identify any reference, or even "common knowledge" to anticipate this element of claim 1. Accordingly, the rejection of claim 1 (and the other dependent claims) is incomplete in that the rejection does not address each and every element in the claim.

2. Claims 18 - 20

Claims 18 - 20 are method claims that each recite metrics data gathered using a hardware device (metering mechanism 113 of Figures 2 and 3) separate from a hardware product 112. Claims 18-20 recite the step of determining data to report based on the acquired metrics data.

3. Claim 27

Method claim 27 recites a "providing a metering mechanism, separate from the hardware product, wherein the metering mechanism obtains the operating data from the hardware product; and providing the obtained operating data to a processing device, wherein usage data are calculated."

4. Claim 37

Claim 37 recites a pay-per-use financing plan comprising ... providing the client site with a mechanism, separate from the hardware product, that acquires the at least one metric, and transmits the at least one metric to a location remote from the client site." In the POTS, when a telephone was used to initiate a call, the measurement of time of call, and call routing (e.g., long distance) occurred at the telephone system remote switching center, and not at the telephone itself. Since the telephone would be at a location corresponding to the client site, the POTS does not anticipate all the elements of claim 37, for example, the above-cited "providing the client site with a mechanism, separate from the hardware product" Accordingly, claim 37 is patentable in view of the POTS.

5. Claim 45

Claim 45 is written in means-plus-function format, and recites, *inter alia*, means for receiving metrics data from the one or more hardware products and means for computing usage an billing data from the received metrics data. The structures disclosed to execute these functions are the metering mechanism 113 and the usage repository 120, and the billing

and accounting system 140. The POTS does not use or suggest the use of such structures to accomplish these functions. Accordingly, claim 45 is patentable in view of the POTS.

Because, as Applicant believes, the POTS does not disclose all the elements of claims 1, 18 - 20, 27, 37, and 45, these claims are patentable. Claims 2, 9, 13, 21 - 25, 29 - 31, 35, 39, 40, 46, and 50 depend from their respective patentable base claims 1, 20, 27, 37, and 45, and for this reason and the additional features they recite, claims 2, 9, 13, 21 - 25, 29 - 31, 35, 39, 40, 46, and 50 also are patentable.

Withdrawal of the rejection of claims 1, 2, 9, 13, 18 - 25, 27, 29 - 31, 35, 37, 39, 40, 45, 46, and 50 under 35 U.S.C. § 102 (b) is respectfully requested.

II. REJECTIONS UNDER 35 U.S.C. § 102 (b) OVER U.S. PATENT 5,745,884

On page 3 the Office Action rejects claims 1 - 4, 8 - 12, 16, 18 - 25, 27, 28, 32, 35, 37 - 41, 44, 45, 48, and 50 - 54 under 35 U.S.C. § 102(b) over U.S. Patent 5,745,884 to Carnegie et al. (hereafter Carnegie). This rejection is respectfully traversed.

The Office Action contends that Carnegie discloses "a hardware pay per use system (title) comprising one or more hardware products (col 4, lines 53 - 56), a metering agent that acquires metrics data (306, 316, as best seen in fig. 3), and a usage repository that generates reports on the received data (308, 318)."

Carnegie is directed to a system for collecting revenues from computer users when those computer users connect their computers through a public network, such as the Internet, to their home network or local area network. *See, e.g.*, Abstract, column 4, lines 30 - 32. Carnegie does not disclose or suggest collecting metrics information related to the operation of the computers, merely the act of connection. *See also*, column 5, lines 45 - 52: Each time a remote user becomes connected to a home system ... the information may be stored for billing purposes on a per user, per connection basis." Clearly, Carnegie's system relates only to connectivity, not operation.

A. Claims 1, 18 - 20, 27, 37, 45, and 53

In contrast to Carnegie, each of the independent claims 1, 18 - 20, 27, 37, 45, and 53 recites a metering mechanism (or corresponding method) that acquires metrics data related to an operation at the hardware products, wherein the metering mechanism determines data to report on the operation of the hardware products. Because Carnegie does not disclose or suggest all the elements of claims 1, 18 - 20, 27, 37, 45, and 53, these claims are patentable.

B. Claim 11

The Office Action asserts that the metrics are provided on a periodic basis. In fact, in Carnegie, and in any telephone system, the "metrics" are provided on an as-called basis. That is, the ANIs and start and stop time for each call are recorded and sent to a central billing location at or near the conclusion of the call.

In contrast to telephone companies, claim 11 recites providing "the metrics on a periodic basis. Thus, claim 11 is patentable over Carnegie and over the telephone companies (the POTS). Claim 11 also is patentable based on its dependence on patentable claim 1.

C. Dependent Claims

Claims 2 - 4, 8 - 10, 12, 16, 21 - 25, 28, 32, 35, 38 - 41, 44, 48, and 50 - 54 depend, respectively, from claims 1, 20, 27, 37, 45, and 53, and for this reason and the additional features they recite, claims 2 - 4, 8 - 10, 12, 16, 21 - 25, 28, 32, 35, 38 - 41, 44, 48, 50 - 52, and 54 also are patentable.

Withdrawal of the rejection of claims 1 - 4, 8 - 12, 16, 18 - 25, 27, 28, 32, 35, 37 - 41, 44, 45, 48, and 50 - 54 under 35 U.S.C. § 102(b) is respectfully requested.

III. REJECTIONS UNDER 35 U.S.C. § 103(a)

On page 5 the Office Action rejects claims 5 - 7, 13 - 15, 26, 29 - 31, 33, 34, 36, 42, 43, 46, 49, and 55 - 61 under 35 U.S.C. § 103(a) over Carnegie.

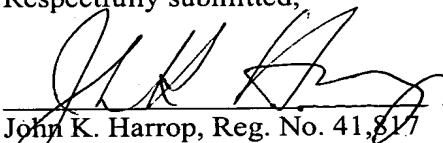
Claims 5 - 7, 13 - 15, 26, 29 - 31, 33, 34, 36, 42, 43, 46, 49, and 55 - 61 depend, respectively, from patentable claims 1, 20, 27, 37, 45, and 53. For this reason and the additional features they recite, claims 5 - 7, 13 - 15, 26, 29 - 31, 33, 34, 36, 42, 43, 46, 49, and 55 - 61 also are patentable.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance and request that a Notice of Allowance be issued. Should the Examiner believe that anything further is required to expedite the prosecution of this application or further clarify the issues, the Examiner is requested to contact Applicants' attorney at the telephone number listed below.

Please charge any necessary fees for this filing to **Deposit Account 08-2025**. Should any additional fees be needed to prevent abandonment of this application, the Examiner is hereby authorized to charge the fees to **Deposit Account 08-2025** and notify the undersigned.

Respectfully submitted,

Date: August 13, 2009


John K. Harrop, Reg. No. 41,817
Andrews Kurth LLP
1350 I Street, NW, Suite 1100
Washington, D.C. 20005
Telephone: (202) 662-3050
Fax: (202) 662-2739